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PATENT APPLICATION

ATTORNEY DOCKET NO. 10016469-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Jeffrey G. Wiley
Application No.: 10/033,225
Filing Date: October 25, 2001

Confirmation No.: 8739
Examiner: Ehlichloya, Fred I.
Group Art Unit: 2162

Title: Data Access Methods and Multifunction Device Therefor

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on February 15, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Date of facsimile: April 2, 2006

Typed Name: Mark D. Trenner
Signature: Mark D. Trenner

Respectfully submitted,

Jeffrey G. Wiley

By Mark D. Trenner

Mark D. Trenner

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Date : April 2, 2006

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Rev 1005 (ReplyB-)

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Rev 10/05 (ReplyBri)

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Inventorship..... Jeffrey G. Wiley
Applicant/Appellant..... Hewlett-Packard Company
Group Art Unit 2162
Examiner Ehichioya, Fred I.
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Attorney's Docket No. 10016469-1
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REPLY BRIEF

To: MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is responsive to the Examiner's Answer mailed February 15, 2006.

This Reply Brief contains items under the following headings, as recommended for reply briefs in MPEP §1208:

- I. Status of claims
- II. Grounds of rejection to be reviewed on appeal
- III. Argument

I. STATUS OF CLAIMS

The status of claims is unchanged from that which was previously stated in the Appeal Brief.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are unchanged from that which was previously stated in the Appeal Brief.

III. ARGUMENT

Examiner's Answer (Section 101):

Appellant appreciates the Examiner withdrawing the 35 U.S.C. §101 rejection.

Examiner's Answer (i):

With regard to the rejection of claim 1, Appellant explained in the Appeal Brief that Czyszewski fails to teach or suggest "identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device." To support this deficiency in his rejection, the Examiner now relies on the doctrine of inherency.

Specifically, the Examiner cites to col. 3, lines 30-33 in Czyszewski and states that "[i]t is inherent when a document is retrieved from a remote datastore, the device has to be specified before retrieving the document from the device." The Examiner also relies on col. 10, lines 25-26, and steps 53 and 55 in Figure 3, and supplies similar explanations that the claim recitations are inherent.

By maintaining his rejection based on inherency, the Examiner is admitting that the claim recitations are not expressly shown in Czyszewski. Appellant agrees with this admission, but respectfully traverses the Examiner's position that Czyszewski inherently discloses these recitations.

First, the Examiner has misinterpreted claim 1. Claim 1 does not merely recite specifying *any* device, as alleged by the Examiner ("it is also inherent that a path is specified when a document is faxed or emailed from the multifunction device either by the fax number or email address of the device/site"). Claim 1 positively recites "identifying said user-specified remote storage device having said electronic document." This is separate and apart from identifying the receiving device, e.g., by entering a fax number.

Second, Appellant believes that Czyszczewski teaches away from the recitations in claim 1. Czyszczewski specifically states that access to the databases is limited and controlled by a remote administrator's database. See, e.g., col. 10, lines 16-20. Czyszczewski also explains that the user can retrieve a document from a remote datastore using predetermined links to the remote datastores. See, e.g., col. 11, lines 20-21 (providing access to a predetermined corporate directory), and col. 11, lines 1-12 (requiring the user to first upload documents to the multifunction device and then go through a security protocol at the multifunction device to access the documents already uploaded to the multifunction device). Therefore, it would not be inherent based on the teachings of Czyszczewski for the user to identify a user-specified remote

storage device having the electronic document based at least in part on a path specified by the user at the multifunction device.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 1 is anticipated by Czyszczeewski.

Examiner's Answer (ii):

Appellant explained in the Appeal Brief that claims 4 and 7-11 are also believed to be allowable for at least the same reasons as claim 1. The Examiner disagreed. However, if claim 1 is found to be allowable, claims 4 and 7-11 depending from claim 1 would necessarily also be allowable.

Examiner's Answer (iii):

In addition to claim 5 being dependent from claim 1 and therefore being allowable for at least the same reasons as claim 1, Appellant explained in the Appeal Brief that Czyszczeewski fails to teach or suggest "combining said document in electronic format with said electronic document from said user-specified remote storage device" as positively recited in claim 5.

The Examiner again relies on Czyszczeewski at Col. 6, lines 53-59, explaining that he interprets the language "commonly used documents in electronic format" as disclosing this recitation. However, Czyszczeewski only

states that the databases may contain copies of commonly used documents in electronic format. There is no disclosure of converting a document to electronic format at the multifunction device and then combining the document with an electronic document from a user-specified remote storage device. The Examiner is reading more into the Czyszczewski reference than is actually disclosed here.

The Examiner also explains that he interprets the language "the multifunction device 10 may also check the website periodically to ensure that it has a current list of document[s]" at col. 6, lines 53-59 in Czyszczewski as disclosing this recitation. Appellant could not find this language at col. 6, lines 53-59, but instead believes the Examiner is referencing col. 10, lines 53-59. Czyszczewski states at col. 10, lines 53-67 (the language believed to be cited by the Examiner is underlined for easy reference):

"Using the multifunction system 10 one can access the website and have the latest, most up-to-date versions of these documents printed, faxed or e-mailed on demand. The user can select the quantity to be printed or copied, and uses the walkup kiosk-like GUI 13, much as an office worker would use a conventional document copier. The multifunction device 10 may also check the website periodically ensure that it has a current list of documents. Then, when a document is chosen, that document is dynamically downloaded each time it is requested, ensuring that only up-to-date documents are utilized. This avoids the problem that arises when paper copies of certain forms are kept in a filing cabinet, and are

not replaced when a particular form is deleted, depleted, revised, or superseded by another form."

However, there is still no disclosure of converting a document to electronic format at the multifunction device and then combining the document with an electronic document from a user-specified remote storage device. Again, the Examiner is reading more into the Czyszczewski reference than is actually disclosed here.

For at least these reasons, claim 5 is believed to be allowable.

Examiner's Answer (iv):

In addition to claim 6 being dependent from claim 1 and therefore being allowable for at least the same reasons as claim 1, Appellant explained in the Appeal Brief that Czyszczewski fails to teach or suggest "combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device" as positively recited in claim 6.

The Examiner reiterates his reasoning from Part (iii) of the Examiner's Answer to sustain the rejection of claim 6. As discussed in Reply to Part (iii) of the Examiner's Answer, the citations and interpretations relied on by the Examiner fail to show that Czyszczewski teaches or suggests combining an electronic document from the user-specified remote storage device with a document converted to electronic format at the multifunction device. Again, the

Examiner is reading more into the Czyszczewski reference than is actually disclosed.

For at least these reasons, claim 6 is believed to be allowable.

Examiner's Answer (v):

With regard to the rejection of claim 12, Appellant explained in the Appeal Brief that Czyszczewski fails to teach or suggest "identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device." To support this deficiency in his rejection, the Examiner now relies on the same arguments of inherency presented in Part (i) of the Examiner's Answer.

By maintaining his rejection based on inherency, the Examiner is admitting that the claim recitations are not expressly shown in Czyszczewski. Appellant agrees with this admission, but respectfully traverses the Examiner's position that Czyszczewski inherently discloses these recitations as discussed above in the above reply to part (i) of the Examiner's Answer.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 12 is anticipated by Czyszczewski.

Examiner's Answer (vi):

Appellant explained in the Appeal Brief that claims 14 and 17-20 are also believed to be allowable for at least the same reasons as claim 12. The Examiner disagreed. However, if claim 1 is found to be allowable, claims 14 and 17-20 depending from claim 12 would necessarily also be allowable.

Examiner's Answer (vii):

Appellant explained in the Appeal Brief that claim 15 is also believed to be allowable for at least the same reasons as claims 5 and 12. The Examiner disagreed. However, if claim 12 is found to be allowable, claim 15 depending from claim 12 would necessarily also be allowable. In addition, if the arguments for allowance of claim 5 (see reply to part iii of the Examiner's Answer, above) are held to be persuasive, these arguments are also persuasive for allowing claim 15.

Examiner's Answer (viii):

Appellant explained in the Appeal Brief that claim 16 is also believed to be allowable for at least the same reasons as claims 6 and 12. The Examiner disagreed. However, if claim 12 is found to be allowable, claim 16 depending from claim 12 would necessarily also be allowable. In addition, if the arguments for allowance of claim 6 (see reply to parts iii and iv of the

Examiner's Answer, above)are held to be persuasive, these arguments are also persuasive for allowing claim 16.

Examiner's Answer (ix):

With regard to the rejection of claim 21, Appellant explained in the Appeal Brief that Czyszewski fails to teach or suggest "including program code for identifying data operatively associated with a user-specified remote storage device; and program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device." To support this deficiency in his rejection, the Examiner now relies on the same arguments of inherency presented in part (i) of the Examiner's Answer.

By maintaining his rejection based on inherency, the Examiner is admitting that the claim recitations are not expressly shown in Czyszewski. Appellant agrees with this admission, but respectfully traverses the Examiner's position that Czyszewski inherently discloses these recitations as discussed above in the above reply to part (i) of the Examiner's Answer.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 21 is anticipated by Czyszczewski.

Examiner's Answer (x):

Appellant explained in the Appeal Brief that claims 22-25 and 27 are also believed to be allowable for at least the same reasons as claim 21. The Examiner disagreed. However, if claim 21 is found to be allowable, claims 22-25 and 27 depending from claim 21 would necessarily also be allowable.

Examiner's Answer (xi):

Appellant explained in the Appeal Brief that claim 26 is also believed to be allowable for at least the same reasons as claims 5 and 21. The Examiner disagreed. However, if claim 21 is found to be allowable, claim 26 depending from claim 21 would necessarily also be allowable. In addition, if the arguments for allowance of claim 5 (see reply to part iii of the Examiner's Answer, above) are held to be persuasive, these arguments are also persuasive for allowing claim 26.

Conclusion

Appellant respectfully requests the Board to rule that the rejections of the claims are improper.

Respectfully Submitted,

Dated: April 2, 2006

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